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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,687	05/18/2006	Joseph Cavan Boyle	051812-1240	9593

24504 7590 05/13/2008
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EXAMINER

GEHMAN, BRYON P

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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05/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,687

Applicant(s)

BOYLE, JOSEPH CAVAN

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 5/15/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The Office is hereby *sua sponte* waiving the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to 01 June 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with § 1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56. Applicants are advised that, notwithstanding the preceding waiver, an applicant who has not disclosed information that is material to patentability as defined in 37 CFR 1.56, because it was believed that the information was not "material to the examination," should disclose such information in order to discharge the applicant's duty of disclosure as required by 37 CFR 1.56, and should file a supplemental oath or declaration acknowledging that duty of disclosure.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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3. The abstract of the disclosure is objected to because it includes legal phraseology in lines 1-2, i.e. "means". Correction is required. See MPEP § 608.01(b).

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 2, the composition of the means for retaining as only one member lacks disclosure as to what such comprises, as only plural raised members are described by the specification.

In claim 3, in what manner the raised members are movable along the outer surface is lacking from the disclosure.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed movable capability of the raised members must be shown or the feature canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3-8, 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, line 1, "the raised members" is inconsistent with claim 2, line 2, "one or more raised members". See also claims 4-8.

In claim 7, line 2, "flanges and/or pins" is alternatively indefinite and should be --at least one of flanges and pins--.

In claim 8, line 2, "at or adjacent" is alternatively indefinite and should be --one of at or adjacent--.

In claim 12, line 2, the listing is alternatively indefinite and should be --at least one of a moulded tray, magnetic material and one or more clips--.

In claim 13, line 2, the listing is again indefinite and should be --one of plastics material, light weight metal and wood--.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 9, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by McGregor (6,460,699). Claims 1-4, 7, 9-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowman (6,371,298). Claims 1-2, 5-8 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Riso (6,343,708). Claims 1-2, 5-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Pepelanov (5,865,105). Claims 1-2, 4-8 and 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Axelrod (5,860,518). Claims 1-8, 10-11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Molinari (4,244,632). Claims 1-2, 5-8

and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Fristedt (3,506,324). Claims 1-2, 5-8, 10-11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Larter (1,720,682). Claims 1-2, 5-9, 11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 296774. Each discloses a portable container capable of carrying tools, the container having an outer surface (having the openings to 20 and 22; at 17; top of 12; top of 22-22C; 61; planar portion of 1; top of 10; 13; top of side walls A; respectively) provided with means (at 20 and 22; 23, 27, 31 or 36-38; 50a-50h and upper side and end walls of 12; 15-16C; 62; pegs 24a and 24; 12 and 14; 17 and 18; upper portions of the handles and sides of A) for retaining a work surface thereon.

As to claim 2, each but McGregor discloses the means for retaining comprising raised members.

As to claim 3, Bowman and Molinari each disclose the raised members (23, 27, 31; 24a) being movable in some manner along the outer surface of the container.

As to claim 4, Bowman, Axelrod and Molinari each disclose the raised members as being detachable with respect to some feature of the container.

As to claims 5 and 6, each but McGregor and Bowman discloses raised members that are fixed (integral can be unitary of fixedly applied) with respect to the outer surface.

As to claim 7, each but McGregor disclosed raised members that are at least one of flanges and pins.

As to claim 8, each but McGregor and Bowman discloses raised members that are one of at or adjacent the periphery of the outer surface.

As to claim 9, McGregor, Bowman, Pepelanov and GB 294776 each disclose the work surface as a board capable of allowing chopping. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As to claim 10, Bowman, Axelrod, Molinari and Larter each disclose the container having an opposed second outer surface having non-slip means (39; rubber feet 52; rubber feet 12; 40).

As to claim 11, each discloses the inside of the container including means for retaining tools.

As to claim 12, Riso, Pepelanov and Axelrod each disclose the means for retaining tools comprising a moulded tray (one of 50a-50h; 30; 100 or 150), the various alternatives disclosed and claimed as obvious variants of one another.

As to claim 13, each discloses at least one of the claimed materials.

As to claim 14, each but McGregor, Bowman and Pepelanov disclose a work surface (80; 70; poster; 18; 15; B; respectively) and a set of tools (contents of 50a-50h; pastels; pens and brushes; shown drawing implements; 27-32; described utensils

As to claim 15, each but McGregor, Bowman and Pepelanov disclose the work surface stored within the confines of the container.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of McGregor and Bowman. McGregor and Bowman do not include a set of tools in their container. However, each is disclosed to be a type of container (tackle box; cutting board) that is commonly used in conjunction with a set of tools. It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate in the disclosed storage portion of either one of McGregor and Bowman with a set of tools that is commonly employed therewith (fishing lures, sinkers, hooks, fishing line cutting tools; cutting tools) as claimed; such a modification would predictably allow for ready use of the tools in conjunction with the container and cutting board. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int 'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are similar containers provided with additional working surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bryon P. Gehman/
Primary Examiner, Art Unit 3728

Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG